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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,328	10/12/2001	Bernd Aldefeld	DE 000174	9218

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

SMITH, RUTH S

ART UNIT PAPER NUMBER

3737

DATE MAILED: 11/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,328

Applicant(s)

ALDEFELD ET AL.

Examiner

Ruth S Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 16, 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 11-15 and 18 is/are rejected.
- 7) ☒ Claim(s) 10, 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2003 has been entered.

***Drawings***

The drawings were received on October 27, 2003. These drawings are acceptable.

***Claim Objections***

Claims 10,14,17,18 are objected to because of the following informalities: It is unclear as to how the structure defined by the localization means differs from the data processing means for determining the position of the localization device in that both means would determine the location of the end zone of the medical instrument. It appears that only one such means for determining the location of the end zone is disclosed. In claim 18, "the first section" lacks antecedent basis. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to disclose any computer program with program sections for executing the method as set forth in the claims or for controlling the device as set forth in the claims or the medical instrument.

Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose any computer program with program sections for executing the method as set forth in the claims or for controlling the device as set forth in the claims or the medical instrument.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11,12,15,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manwaring et al. Manwaring et al disclose an apparatus including an endoscope for providing live video images 44, an imaging means for providing and storing survey images 42 and localization means which located the position of the endoscope and superimposes such on the survey image. The localization means uses a magnetic field sensor 30'and an external measuring device 28. The apparatus includes a computer for

carrying out the method of using the apparatus as seen in the flow charts provided. With respect to claim 5, the sensing coils are inherently detectable by a magnetic resonance device or an ultrasound device. Manwaring et al disclose placing the sensor 30' on the handle and determining the location of the tip (end zone) using the known fixed relationship between the location of the sensor and the location of the tip relative to the sensor. In the absence of any showing of criticality or unexpected results, placing the sensor 30' at the tip or a fixed distance from the tip would have been a matter of obvious engineering design choice that would not result in any different outcome during the use of the device. Placing the sensor at either the tip or a known fixed distance from the tip would allow a user to easily determine the position of the tip using the position determining means set forth. It should be noted with respect to claim 12, that an endoscope is considered to be a type of catheter. With respect to claim 18, it appears that an endoscope used by Manwaring would inherently include a flexible section as is well known in the art.

#### ***Allowable Subject Matter***

Claims 1-9,16,19,20 are allowable over the prior art of record.

#### ***Response to Arguments***

Applicant's arguments filed October 27, 2003 have been fully considered but they are not persuasive. It should be noted that examiner clearly stated that Manwaring fails to disclose the use of a sensor at an end zone of the instrument. The examiner stated in the absence of any showing of criticality or unexpected results, placing the sensor 30' at the tip or a fixed distance from the tip would have been a matter of obvious engineering design choice that would not result in any different outcome during the use of the device. Placing the sensor at a known fixed distance from the tip would allow a user to easily determine the position of the tip using the position determining means set forth, therefore, applicant's claimed invention is obvious in view of the teachings of Manwaring. Furthermore, it should be noted that Manwaring does disclose including indications of markers in the survey image as seen by reference numeral 64'. With

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respect to the rejections under 35 USC 112, first paragraph, the section referred to in the MPEP deals with the "best mode" requirement. The rejections currently outstanding are based on written description and enablement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (703) 308-3063. The examiner can normally be reached on M-F 5:30 AM- 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Ruth S Smith  
Primary Examiner  
Art Unit 3737

RSS